

### REMARKS

Claims 8 to 14 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 8 to 14 were rejected under 35 USC § 102(b) as anticipated by Manfred et al., German Patent App. Pub. No. DE 198 31 748, and also under 35 USC § 102(e) as anticipated by Tonetti et al., U.S. Patent No. 7,044,118.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b) or (e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 8 is to “[a] method for controlling an internal combustion engine,” including the feature of “determining, based on performance characteristics, a first quantity characterizing an actual injected fuel amount and a second quantity characterizing a desired fuel amount to be injected,” and the feature of “defining, based on a result of the comparison, a first correction value for correcting a fuel amount and a second correction value for correcting an air amount, wherein the first correction value is limited to a selected maximum value.”

It is respectfully submitted that any review of the applied references makes plain that the Manfred and Tonetti references simply do not identically disclose (nor even suggest) the feature in which a first correction value is limited to a selected maximum value, as provided for in the context of the claim. Therefore, the references do not and cannot identically disclose (nor even suggest) the feature “defining, based on a result of the comparison, a first correction value for correcting a fuel amount and a second correction value for correcting an air amount, wherein the first correction value is limited to a selected maximum value”, as provided for in the context of the claim.

Accordingly, claim 8 is allowable, as are its dependent claims 9 to 13.

Claim 14 is to “[a] device for controlling an internal combustion engine,” including the feature of “a control unit for controlling” and *“defining, based on a result of the comparison, a first correction value for correcting a fuel amount and a second correction value for correcting an air amount, wherein the first correction value is limited to a selected maximum value”*.

As explained above, the Manfred and Tonetti references do not identically disclose (nor even suggest) the feature of defining, based on a result of the comparison, a first correction value for correcting a fuel amount and a second correction value for correcting an air amount, in which the first correction value is limited to a selected maximum value, as provided for in the context of the claim.

Accordingly, claim 14 is allowable for the foregoing reasons.

In sum, claims 8 to 14 are allowable.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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